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| EXAMINER |
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3627

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/832,921

Applicant(s)

MASAKI, KAZUNORI

Examiner

Andrew J. Fischer

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9,43-51,67 and 68 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9,43-51,67 and 68 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Acknowledgements*

1. Applicant's amendment filed December 9, 2004 is acknowledged. The December 9, 2004 amendment was in response to the Examiner's Office Action mailed September 9, 2004 ("Third Non Final Office Action"). Accordingly, claims 1-9, 43-51, 67, and 68 remain pending.
2. This Office Action is written in OACS. Because of this, the Examiner is unable to control formatting, paragraph numbering, font, spelling, line spacing, and/or other word processing issues. The Examiner sincerely apologizes for these errors.
3. This application is in an image file wrapper ("IFW") application. Applicant's response is therefore disassembled before being placed into the IFW system (*i.e.* claims, remarks, drawings, etc. are separated and independently scanned). To ensure proper handling by the Examiner, the Examiner highly recommends Applicant place the application serial no (*e.g.* 06/123,456) in a header or footer (or other appropriate area) of *each* page submitted. At the very least, the Examiner highly recommends this practice for all pages listing the claims.

### *Specification*

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 C.F.R. §1.75(d)(1), MPEP §608.01(o), and MPEP §2181. The specification is replete with these errors. Some examples follow:
  - a. The "means for detecting a request for a designed item" as recited in claim 4.
  - b. The "means for presenting a user interface" as recited in claim 4.
  - c. The "means for detecting a basic service requested by a user" as recited in claim 43.

***Claim Rejections - 35 USC §101***

5. 35 U.S.C. §101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 7-9, 47, and 48 are rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter. The basis of this rejection is set forth in a two-prong test:

- (1) The invention must be within the technological arts; and
- (2) The invention must produce a useful, concrete, and tangible result.

7. Prong (1) requires the claimed invention to be within the technological arts. See *In re Musgrave*, 431 F.2d 882, 167 USPQ 280, 289-90 (C.C.P.A. 1970); and *In re Johnston*, 502 F.2d 765, 183 USPQ 172, 177 (C.C.P.A. 1974). Mere abstract ideas (*i.e.*, laws of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the “progress of science and the useful arts”<sup>1</sup> and are therefore non-statutory subject matter.<sup>2</sup>

8. For a process (*i.e.* claims 46 and 46), the claimed process must somehow apply, involve, use, or advance the technological arts. Mere intended or nominal use of a component—albeit within the technological arts—does not confer statutory subject matter to an otherwise abstract idea if the component does not apply, involve, use, or advance the underlying process. In other words, if the invention in the body of the claim is not tied to a technological art, environment, or machine, the claim is non-statutory. *Ex parte Bowman*, 61 USPQ2d 1665, 1671 (B.P.A.I. 2001)

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<sup>1</sup> It is the Examiner’s position that “technological arts” is synonymous with “useful arts” as stated in the U.S. Constitution, Art. I, §8. See *In re Waldbaum*, 457 F.2d 997, 173 USPQ 430, 434 (C.C.P.A. 1972).

<sup>2</sup> *E.g.*, the physical sciences are statutory; *c.f.*, social sciences which are non-statutory

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(Unpublished). See also MPEP §2106 IV B. 2 (b) ii). The Examiner recommends (by way of example only) positive recitation of a computer or other technology within the body of the claim if the specification supports such an amendment.

9. Regarding the product claims (*i.e.* claims 47 and 48), they too fail to produce a useful, concrete, and tangible result.

***Claim Rejections - 35 USC §112 2<sup>nd</sup> Paragraph***

10. The following is a quotation of the 2<sup>nd</sup> paragraph of 35 U.S.C. §112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 4-6, 43, 44, are rejected under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are replete with errors. Some examples follow:

12. In claims 4 and 43, Applicant has not clearly linked and associated the “means for” phrases to any corresponding structure.

***Claim Rejections - 35 USC §102***

13. The following is a quotation of the appropriate paragraphs of 35 U.S.C. §102 that form the basis for the rejections under this section made in this Office Action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States. . . .

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

14. Claims 1-9, 43-51, 67, and 68, as understood by the Examiner, are rejected under 35

U.S.C. §102(e) as being anticipated by Adamske et. al. (U.S. 6,615,234 B1)(“Adamske”).

Discloses detecting a first print setting (which particular drawer the paper will be drawn from); a second print setting (print 2 sides or 1 side); a third print setting (size of the paper to be printed on); a forth print setting (whether or not to use staples); a fifth print setting (increasing or decreasing the contrast) displaying these print settings to a user; selecting an output server (the server in which the user is connected to).

15. Finally, claims 1-9, 43-51, 67 and 68, as understood by the Examiner, are rejected under 35 U.S.C. §102(b) as being anticipated by Huberman (U.S. 5,826,244). Huberman discloses detecting a request for services (for printer services); detecting an upper limit to be paid for the services (the upper limit with the user’s price range); displaying a user interface (a webpage) to enable a user to select one of the designated pay service (the lowest bidder) or a pay service other than the designated pay service (the non lowest bidder or ever some completely new service within the user’s price range).

### ***Claim Rejections - 35 USC §103***

16. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office Action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 1, 2, 4, 5, 7, 8, 49, 50, as understood by the Examiner, are alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Adamske.<sup>3</sup> It is the Examiner's principle position that the claims are anticipated because Adamske discloses credit accounts and the associated features of credit accounts are inherent.

However if not inherent, Therefore it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Adamske to substitute services for products. It is the Examiner's position that paying for either a products or services have become art recognized equivalents. See MPEP §2144.06.

18. Claims 1-9, 43-51, 67 and 68, as understood by the Examiner, are also alternatively rejected under 35 U.S.C. §103(a) as being unpatentable over Huberman.<sup>4</sup> Again, it is the Examiner's principle position that the claims are anticipated. However if not anticipated, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify Huberman to include any missing features. These modifications would be considered insubstantial and will not patentably distinguish the claimed invention over the prior art.

19. Since Applicant did not seasonably traverse the Official Notice statements as stated in the Second Non Final Office Action (Paragraph No. 21), the Official Notice statements are taken to be admitted prior art. See MPEP §2144.03.

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<sup>3</sup> See MPEP §2112 expressly authorizing alternative §102/§103 rejections when the question of inherency is present in the anticipation rejection.

<sup>4</sup> Id.

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20. The Examiner confirms that Applicant has elected not to recite any product-by-process claims. See the Second Non Final Office Action, Paragraph No. 25.

21. Although Applicant uses “a step of” in the claim(s) (*e.g.* claim 47 recites “a step of detecting”), it is the Examiner’s position that the “a step of” phrase(s) do not invoke 35 U.S.C. 112 6<sup>th</sup> paragraph because they fail prong (1) as set forth in MPEP §2181. If Applicant desires to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph, the Examiner respectfully reminds Applicant to change the phrase(s) to “step for” where 35 U.S.C. 112 6<sup>th</sup> paragraph is desired. Upon receiving such express invocation of 35 U.S.C. 112 6<sup>th</sup> paragraph, the “step for” phrase(s) will be interpreted as set forth in the *Supplemental Examination Guidelines for Determining the Applicability of 35 USC 112 6<sup>th</sup>*.<sup>5</sup> Failure by Applicant in his next response to also address the 35 U.S.C. 112 6<sup>th</sup> paragraph issues in accordance with 37 C.F.R. §1.111(b) or to be non-responsive to this issue entirely will be considered a desire by Applicant NOT to invoke 35 U.S.C. 112 6<sup>th</sup> paragraph. Unless expressly noted otherwise by the Examiner, the preceding discussion on 35 U.S.C. 112 6<sup>th</sup> paragraph applies to all examined claims currently pending.

22. The Examiner concludes that Applicant has decided not to be his own lexicographer by indicating and defining claim limitations to have meanings other than their ordinary and accustomed meanings. To support this position, the Examiner relies on the following factual findings. First and as noted in the previous Third Non Final Office Action,<sup>6</sup> the Examiner has carefully reviewed the specification and prosecution history and can not locate any lexicographic definition(s). Second, the Examiner finds that not only has Applicant not pointed to definitional

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<sup>5</sup> Federal Register Vol. 65, No. 120, June 21, 2000.

<sup>6</sup> See the Third Non Final Office Action, Paragraph No. 23.



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statements in his specification or prosecution history, Applicant has also not pointed to a term or terms in a claim with which to draw in those statements<sup>7</sup> with the required clarity, deliberateness, and precision.<sup>8</sup> Third, after receiving express notice in the previous Office Action of the Examiner's position that lexicography is not invoked,<sup>9</sup> Applicant has not pointed out the "supposed errors" in the Examiner's position regarding lexicography invocation in accordance with 37 C.F.R. §1.111(b) (*i.e.* Applicant has not argued lexicography *is* invoked). Finally and to be sure of Applicant's intent, the Examiner also notes that Applicant has declined the Examiner's express invitation<sup>10</sup> to be his own lexicographer.<sup>11</sup> Accordingly and for due process purposes, the Examiner gives notice that for the remainder of the examination process (and unless a claim phrase successfully invokes 35 U.S.C. §112 6<sup>th</sup> paragraph), the heavy presumption in favor of the

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<sup>7</sup> "In order to overcome this heavy presumption in favor of the ordinary meaning of claim language, it is clear that a party wishing to use statements in the written description to confine or otherwise affect a patent's scope must, *at the very least*, point to a term or terms in the claim with which to draw in those statements. [Emphasis added.]" *Johnson Worldwide Assocs. v. Zebco Corp.*, 175 F.3d 985, 989, 50 USPQ2d 1607, 1610 (Fed. Cir. 1999).

<sup>8</sup> "The patentee's lexicography must, of course, appear 'with reasonable clarity, deliberateness, and precision' before it can affect the claim." *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1249, 48 USPQ2d 1117, 1121 (Fed. Cir. 1998) citing *In re Paulsen*, 30 F.3d 1475, 1480, 31 USPQ2d 1671, 1674 (Fed. Cir. 1994).

<sup>9</sup> See again the Third Non Final Office Action, Paragraph No. 23.

<sup>10</sup> *Id.*

<sup>11</sup> The Examiner's requirements on this matter were reasonable on at least two separate and independent grounds. First, the Examiner's requirements were simply an express request for clarification of how Applicant intend his claims to be interpreted so that lexicography (or even an *attempt* at lexicography) by Applicant was not inadvertently overlooked by the Examiner. Second, the requirements were reasonable in view of the USPTO's goals of compact prosecution, productivity with particular emphasis on reductions in both pendency and cycle time, and other goals as outlined in the USPTO's The 21<sup>st</sup> Century Strategic Plan, February 3, 2003 available at [www.uspto.gov/web/offices/com/strat21/index.htm](http://www.uspto.gov/web/offices/com/strat21/index.htm) (last accessed March 12, 2005).

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ordinary and accustomed meaning is not overcome; the claims therefore continue to be interpreted with their “broadest reasonable interpretation . . . .” *In re Morris*, 127 F.3d 1048, 1054, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).<sup>12</sup> The Examiner now relies heavily and extensively on this interpretation.<sup>13</sup> Unless expressly noted otherwise by the Examiner, the preceding claim interpretation principles in this paragraph apply to all examined claims currently pending.

23. Under the broadest reasonable interpretation standard noted above and unless modified in this Office Action, the Examiner maintains his interpretations including the statements and/or definitions of claim limitations as noted in previous Office Action. Those previous definitions are part of the administrative record and, in accordance with *In re Morris*, are provided simply as a factual source to support the Examiner’s claim interpretations (and ultimately the Board of Patent Appeals and Interferences claim interpretations if necessary<sup>14</sup>) during *ex parte* examination.

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<sup>12</sup> See also *In re Bass*, 314 F.3d 575, 577, 65 USPQ2d 1156, 1158 (Fed. Cir. 2002) (“In examining a patent claim, the PTO must apply the broadest reasonable meaning to the claim language, taking into account any definitions presented in the specification. Words in a claim are to be given their ordinary and accustomed meaning unless the inventor chose to be his own lexicographer in the specification”) (citations omitted); *In re Etter*, 756 F.2d 852, 858, 225 USPQ 1, 5 (Fed. Cir. 1985) (en banc); and MPEP §§ 2111 and 2111.01.

<sup>13</sup> See 37 C.F.R. §1.104(c)(3) which states in part: “the examiner may rely upon admissions by applicant . . . as to *any matter* affecting patentability . . . . [Emphasis added.]”

<sup>14</sup> See *Gechter v. Davidson*, 116 F.3d 1454, 1460, 43 USPQ2d 1030, 1035 (Fed. Cir. 1997) (“[W]e hold that the Board is required to set forth in its opinions specific findings of fact and conclusions of law adequate to form a basis for our review.”).

***Response to Arguments***

24. Applicant's arguments filed December 9, 2004 have been fully considered but they are not persuasive.

25. Applicant's arguments with respect to the objections to the specification have been considered but are not persuasive. Again see MPEP §608.01(o) and MPEP §2181.

26. With respect to the §101 rejection, the Examiner notes that claim 7 begins "A memory medium . . . ." It is the Examiner's position that it impossible to place anything other than computer code within the medium. Therefore because Applicant has chosen to begin the claim with "A memory medium," the claims are limited to a memory medium and items containable therein. Because the claim is limited to a single memory medium, a computer, a computer monitor, printer, network connections, and all other hardware must be outside the scope of the claims since they are not a memory medium and are not even capable of being placed within a memory medium. Applicant's arguments have been considered but are not persuasive.

27. Regarding Applicant's 35 U.S.C. §112 6<sup>th</sup> paragraph comments, the Examiner first notes that contrary to Applicant's statements, the claims are not "rejected" under 35 U.S.C. §112 6<sup>th</sup> paragraph. There is no such thing as a rejection under 35 U.S.C. §112 6<sup>th</sup> paragraph. Moreover, the Examiner maintains his position that the 'means for phrases must also be clearly linked and associated with corresponding structure found in the specification.

28. It is the Examiner's position that because Applicant does not recite "step for" in claims 7-19, it is the Examiner's position that the claims do not invoke 35 U.S.C. §112 6<sup>th</sup> paragraph. See the Second Non Final Office Action, Paragraph No. 26.

29. Applicant argues that he "fails to see *anything* in Huberman in which a second print setting information is determined for a second print service in accordance with detected first

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print setting information for a first print service and a detected upper limit of a charge designated by a user to be paid for the first print service. [Emphasis added.]”<sup>15</sup> First, the Examiner has carefully reviewed the independent claims and can not locate a “second print setting information is determined for a second print service in accordance with detected first print setting information for a first print service and a detected upper limit of a charge designated by a user to be paid for the first print service.” As Judge Clevenger has so eloquently summarized these types of arguments, “The invention disclosed in [Applicant’s] written description may be outstanding in its field, but the name of the game is the claim.” *In re Hiniker Co.*, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). For this reason alone, Applicant’s arguments are not persuasive.

30. Second, even if such a statement *was* found in the claims (albeit a big “if”), the Examiner respectfully disagrees. Huberman directly discloses selecting page size (*e.g.* ‘8 ½ x 11’) and black and white ink. Therefore, Applicant’s statement that he “fails to see *anything* in Huberman in which second print setting information is determined for a second print service in accordance with detected first print setting information for a first print service” is simply not true. ‘8 ½ x 11’ paper size and black and white ink over color ink is “something.” Because Applicant’s initial premise is not true, his remaining arguments are moot. Applicant’s arguments have therefore been considered but are not persuasive.

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<sup>15</sup> Applicant’s Remarks filed December 9, 2004, Page 17, 1<sup>st</sup> ¶.

### ***Conclusion***

31. Applicant's amendment necessitated the new grounds of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP §706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. §1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 C.F.R. §1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

32. References considered pertinent to Applicant's disclosure are listed on form PTO-892. Unless expressly noted otherwise by the Examiner, all references listed on form PTO-892 are cited in their entirety.

33. The following two (2) citations to the Manual of Patent Examining Procedure ("MPEP") apply to this Office Action: MPEP citations to Chapters 100, 200, 500, 600, 700, 1000, 1100, 1300, 1400, 1500, 1700, 1800, 2000, 2100, 2200, 2500, 2600, and 2700 are from the MPEP 8<sup>th</sup> Edition, Rev. 2, May 2004. All remaining MPEP citations are from MPEP 8<sup>th</sup> Edition, August 2001.

34. Also in accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that Nathan J. Muller's Desktop Encyclopedia of the Internet, ("Desktop Encyclopedia") is additional evidence of what is basic knowledge or

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common sense to one of ordinary skill in this art. Muller's Desktop Encyclopedia is a practical reference that clearly explains Internet services, applications, protocols, access methods, development tools, administration and management, standards, and regulations. Because of the reference's basic content (which is self-evident upon examination of the reference) and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that the Desktop Encyclopedia is primarily directed towards those of low skill in this art. Because the reference is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within the Desktop Encyclopedia.

35. Also in accordance with *In re Lee*, the Examiner finds that the reference Introduction to Financial Accounting, Revised 3<sup>rd</sup> Ed. by Horngren et. al. ("Horngren") is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. The Examiner finds that Horngren describes basic financial accounting practices permitting the user to obtain a thorough grasp of the fundamentals of accounting. The reference is cited in its entirety. Moreover, because the reference is a introductory accounting textbook that presupposes no prior knowledge of accounting, because of the reference's basic content which is self evident upon review of the reference, and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that Horngren is primarily directed towards those of low skill in this art. Because Horngren is directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within Horngren.

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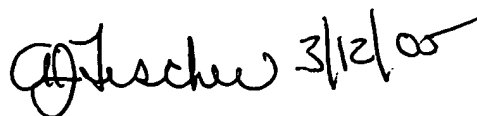
36. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

37. Because this application is now final, Applicant is reminded of the USPTO's after final practice as discussed in MPEP §714.12 and §714.13 and that entry of amendments after final is *not* a matter of right. "The refusal of an examiner to enter an amendment after final rejection of claims is a matter of discretion." *In re Berger*, 279 F.3d 975, 984, 61 USPQ2d 1523, 1529 (Fed. Cir. 2002) (citations omitted). Furthermore, suggestions or examples of claim language provided by the Examiner are just that—suggestions or examples—and do not constitute a formal requirement mandated by the Examiner. Unless stated otherwise by an express indication that a claim is "allowed," exemplary claim language provided by the Examiner to overcome a particular rejection or to change claim interpretation has *not been addressed* with respect to other aspects of patentability (*e.g.* §101 patentable subject matter, §112 1<sup>st</sup> paragraph written description and enablement, §112 2<sup>nd</sup> paragraph indefiniteness, and §102 and §103 prior art). Therefore, any claim amendment submitted under 37 C.F.R. §1.116 that incorporates an Examiner suggestion or example or simply changes claim interpretation will nevertheless require further consideration and/or search and a patentability determination as noted above.

38. In accordance with the USPTO's goals of customer service, compact prosecution, and reduction of cycle time, the Examiner has made every effort to clarify his position regarding claim interpretation and any rejections or objections in this application. Furthermore, the

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Examiner has again provided Applicants with notice—for due process purposes—of his position regarding his factual determinations and legal conclusions. The Examiner notes and thanks Applicant for his “Remarks” (beginning on page 11) traversing the Examiner’s positions on various points. If Applicant disagrees with any additional factual determination or legal conclusion made by the Examiner in this Office Action whether expressly stated or implied,<sup>16</sup> the Examiner respectfully reminds Applicant to properly traverse the Examiner’s position(s) in accordance with 37 C.F.R. §1.111(b) in his next properly filed response. By addressing these issues now, matters where the Examiner and Applicant agree can be eliminated allowing the Examiner and Applicant to focus on areas of disagreement (if any) with the goal towards allowance in the shortest possible time. If Applicant has any questions regarding the Examiner’s positions or has other questions regarding this communication or even previous communications, Applicant is strongly encouraged to contact Examiner Andrew J. Fischer whose telephone number is (703) 305-0292. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner’s immediate supervisor, Robert Olszewski, can be reached at (703) 308-5183. The fax number for facsimile responses is now (703) 872-9306.



Andrew J. Fischer  
Primary Examiner  
Art Unit 3627

AJF  
March 12, 2005

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<sup>16</sup> *E.g.*, if the Examiner rejected a claim under §103 with two references, although not directly stated, it is the Examiner’s implied position that the references are analogous art.